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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,865	09/05/2003	Alberto Silvestri	1006-002us	8102
7590 09/20/2004				
SOFER & HAROUN, LLP				
Suite 910				
317 Madison Avenue				
New York, NY 10017				
EXAMINER				
ABDELWAHED, ALI F				
ART UNIT		PAPER NUMBER		
3712				

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/656,865

**Applicant(s)**

SILVESTRI, ALBERTO

**Examiner**

Ali Abdelwahed

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-19 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

**Note to Applicant:** Under rule 1.126, Examiner has renumbered claims 1-20 to now read 1-19 to take into account the missing claim 4, which was not entered into the claim numbering. Accordingly, the claims dependencies have also been renumbered. The new Office Action below has made reference to the claims according to their new numbering. Examiner requests that Applicant also make appropriate corrections to the claims in response to this Office Action.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the coupling between the panels being formed along a perforated edge, the panels containing individual advertisements designed to be removed independently from one another, the individual advertisements being any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations, the panels being constructed of a two-ply material forming first and second sides of each panel, such that each side of the panels displays different advertising material, the first and second panels each maintain images, that when combined, form a larger single image, the second sides of the first and second panels each maintain separate images, such that when the first and second panels are folded the second sides of the panels combine to form a larger single image, a plurality of pages with at least one page having an image displayed thereon, the printed panels are folded over the image on the page, the image on the page is altered,

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and when the printed panels are folded over the image on the page, the image on the page remains the same in claims 5-13, and 17-19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 7, 12, 13, and 19 are objected to because of the following informalities:

It is suggested that in:

Claims 7 and 19, line 2, delete "advertisement designs" and insert – advertisements--.

Claims 12 and 13, line 1, delete "printed".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,520,560 to Isaac.

Isaac discloses an advertisement display (1) for placement within a printed publication (see fig.1), the display comprising: a plurality of panels (10-15), each of the panels having at least one edge thereon (8, 23), wherein a first panel (11), among the plurality of panels and attached to the printed publication, is coupled to at least one second panel (10) among the plurality of panels along at least one edge of the first panel (see fig.1), such that the second panel is configured to be folded onto the first panel along the edge (see figs. 2, 3); a third panel (12) coupled to at least one edge of the second panel (see fig.1), wherein the third panel is configured to be folded onto the second panel before the second panel is folded onto the first panel (see figs. 3, 4); the coupling between the panels is formed along a solidly formed edge (see fig.1, [edge 8]);

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the coupling between the panels is formed along a perforated edge (see fig.1, [edge 23]); the panels contain individual advertisements designed to be removed independently from one another (see figs.1, 4, and respective portions of the specification); and the individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations (see figs.1, 4).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,629,800 B1 to Brown.

Brown discloses an advertisement display (1) for placement within a printed publication (see figs. 3-6, and respective portions of the specification), the display comprising: a plurality of panels (7-11, 16-19), each of the panels having at least one edge thereon (12-15, 20-23), wherein a first panel (19), among the plurality of panels and attached to the printed publication, is coupled to at least one second panel (16) among the plurality of panels along at least one edge (22) of the first panel (see figs. 4, 6), such that the second panel is configured to be folded onto the first panel along the edge (see figs. 4, 6, and respective portions of the specification); a third panel (17) coupled to at least one edge (20) of the second panel (see figs. 4, 6), wherein the third panel is configured to be folded onto the second panel before the second panel is

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folded onto the first panel (see figs. 4, 6, and respective portions of the specification); a fourth panel (18) coupled to a second edge (23) of the first panel (see figs. 4, 6), wherein the fourth panel is configured to be folded onto the first panel before the second panel is folded onto the first panel (see figs. 4, 6, and respective portions of the specification); the coupling between the panels is formed along a solidly formed edge (see figs. 4, 6, and respective portions of the specification); and the first and second panels each maintain images, that when combined, form a larger single image (see figs. 5, 6).

Claims 1-4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,752,427 B1 to Wilen.

Wilen discloses an advertisement display (70) for placement within a printed publication (see columns 3 and 4, lines 36-38, 63-67 and 1-2, respectively), the display comprising: a plurality of panels (see fig. 9), each of the panels having at least one edge thereon (see fig. 9), wherein a first panel (defined by the panel on the very left end of the top row E), among the plurality of panels and attached to the printed publication, is coupled to at least one second panel (defined by the panel on the very left end of the middle row F, also the panel directly beneath the afore stated first panel) among the plurality of panels along at least one edge of the first panel (see fig. 9), such that the second panel is configured to be folded onto the first panel along the edge (see figs. 9-14); a third panel (defined by the panel second to the very left end of the middle row F, also the panel directly to the right of the afore stated second panel) coupled to at least

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one edge (77) of the second panel (see fig. 9), wherein the third panel is configured to be folded onto the second panel before the second panel is folded onto the first panel (see figs. 9-14); a fourth panel (defined by the panel second to the very left end of the top row E, also the panel directly to the right of the afore stated first panel) coupled to a second edge (15) of the first panel (see fig. 9), wherein the fourth panel is configured to be folded onto the first panel before the second panel is folded onto the first panel (see figs. 9-14); the coupling between the panels is formed along a solidly formed edge (see figs. 9-14, and respective portions of the specification); and the first and second panels each maintain images, that when combined, form a larger single image (see columns 3 and 4, lines 36-38, 63-67 and 1-2, respectively).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilen in view of U.S. Patent No. 6,572,149 B2 to Long.

Wilen discloses the claimed invention except for the coupling between the panels being formed along a perforated edge; the panels contain individual advertisements designed to be removed independently from one another; and the individual advertisements are any one of coupons, business cards, product samples, a mailer for



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return mailing, and a list of store locations. However, Long teaches an advertisement display (10) comprising a coupling between the panels (11) being formed along a perforated edge (13); the panels contain individual advertisements designed to be removed independently from one another (see fig.1, and respective portions of the specification); and the individual advertisements are any one of coupons, business cards, product samples, a mailer for return mailing, and a list of store locations (see figs.1, 3, 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the advertisement display of Wilen, in view of Long, such that it would provide the advertisement display of Wilen with the concept of the aforementioned limitations for the purpose of enhancing the effectiveness of the advertisement display to provide the recipient with many more choices of advertisements to choose from.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilen in view of U.S. Patent No. 5,169,060 to Tighe et al.

Wilen discloses the claimed invention except for the panels being constructed of a two-ply material forming first and second sides of each panel, such that each side of the panels displays different advertising material, and the second sides of the first and second panels each maintain separate images, such that when the first and second panels are folded the second sides of the panels combine to form a larger single image. However, Tighe et al. teaches an advertisement display comprising the aforementioned limitations (see figs.1-4, and respective portions of the specification). Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the advertisement display of Wilen, in view of Tighe et al., such that it would provide the advertisement display of Wilen with the concept of the aforementioned limitations for the purpose of enhancing the aesthetic value of the display and to enhance the effectiveness of the advertisement display to provide the recipient with more advertisements to view.

***Allowable Subject Matter***

Claims 11-19 are allowed.

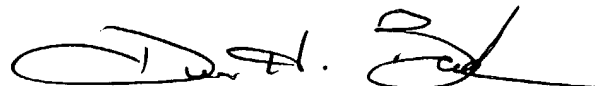
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA  
09/15/2004



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